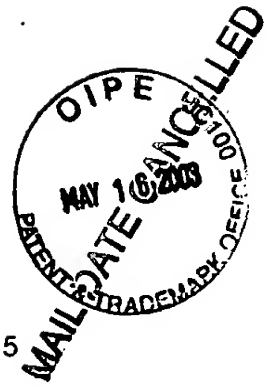

AFTER FINAL

PATENT APPLICATION
DOCKET NO.:10981718-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 2172

EXAMINER: Woo, Isaac M

SERIAL NO.: 09/368635

CONF. NO.: 5764

INVENTOR(S): Arlitt, M.F.

FILING DATE: 08/04/1999

TITLE: Improving Content Consistency in a Data Access Network System

PETITION : FROM DESIGNATION OF ACTION AS "FINAL"

To: THE ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON D.C. 20231

This paper is filed in replay to the Final Office Action, date mailed 04/22/2003. Applicants hereby request relief for the designation of the Action as "Final."

1. The Office has issued a second Action, designating it "Final." This second Action, at page 2, in para. 3 thereof, cites for the first time U.S. Patent No. 6,205,481, alleging claims 1-7 (all claims) are obvious under 35 U.S.C. 103. The Action then has three (3) pages of argument, posing various allegations against specific claims as amended by the applicant in response to the first Office Action (date mailed Feb. 18, 2003).

2. MPEP 706.07(a) is clear: ". . .second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant's am ndment of the claims nor based on information submitt d in an information disclosure statement. . .."

3. At page 2, para. 1 of the Action, regarding applicants Response, including 4 full pages of arguments, the Examiner replies *inter alia*: "Applicant's amendment, fil d on February 21, 2003 have been fully considered but are deemed moot in view of the new ground of rejections below." At page 6, para. 5, of the Action, the Examiner states: "Applicant's amendment necessitated the new ground(s) of rejection presented in the Office action." Neither statement is correct.

3. Applicant's response to the First Office Action included detailed arguments regarding the inapplicability of previously cited, now dropped references and minimal amendments. Only claim 1 and claim 6 were amended only as to form and, as shown by the following, *no substantive changes were made:*

> "1. (Third amended) In a data access network system that includes a content server coupled to a plurality of proxy servers via an interconnect network, a system of maintaining content consistency between the content server and proxy servers, comprising:
>
> a subscription manager in the content server [to] for specifying all of the proxy servers that are subscribed to a content file stored in the content server; and
>
> a consistency manager also in the content server [to] for notifying all of [the] so subscribed proxy servers that cache the content file when the content file is updated in the content server to discard the cached content file from those proxy servers [when the content file is updated in the content server].
>
> 6. (First amended) The system of claim 1, wherein the consistency manager also sends [the] an updated content file to each of the proxy servers via an HTTP PUT request with a DWS SUB header."

The Examiner has introduced a new ground not necessitated by a prior amendment.

4. There is clearly in this case no "Switching from one subject matter to another in the claims presented by applicant. . .." MPEP 706.07. However, there is now a switch by the Examiner of the reference cited. There simply is no reasonabl argument that in such an instance applicant's amendm nt necessitated the new reference. Considering the

application and claims as a whole, if the newly cited refer nce is r levant now (which it is not, as argued in the After Final Reply filed herewith), it must have been relevant previously. Applicant has been afforded no opportunity to argue and amend, if appropriate, with respect to this new ground for rejection.

5. The MPEP is specific: "Before final rejection is in order a clear issue should be developed between the examiner and applicant." MPEP 706.07, first sentence.

> ". . .applicant is entitled to a full and fair hearing, and that a clear issue between applicant and the examiner should be developed."

Neither the now dropped references nor the newly cited reference to suggests, motivates or makes obvious applicant's invention. Applicant has not made substantive changes to the claims, yet an entirely new reference is applied by the Final Office Action. It is evident that no "clear issue" is defined yet in this prosecution.

6. Furthermore, applicant will be both legally prejudiced and financially prejudiced - by requirement of fees and the like to continue other prosecution or appeal routes - should the Action be allowed to stand as "Final."

7. It is respectfully petitioned that the designation of the Action as "Final" be withdrawn.

Dated: JUNE 12, 2003

Respectfully submitted,

Eugene H. Valet

Eugene H. Valet
Reg. No. 31435